

Amendments to the Drawings

None

Remarks

Applicant thanks the Examiner for the Written Office Action.

With regard to the substantive portion of the Written Office Action, Claims 14 - 20 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 1-14 were rejected under 35 U.S.C. 101 because the claimed invention was directed to non-statutory subject matter. Claims 14-20 were rejected under 35 U.S.C. 101 because the claimed invention was directed to non-statutory subject matter. Claims 1-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cooperstone et al. in view of Chao.

In response to the written office Action, the Applicant respectfully submits the following remarks. In addition, the Applicant respectfully submits that Claims 1 and 14 have been amended and Claims 17-19 have been canceled.

35 U.S.C. § 112, Second Paragraph

In response to rejected Claims 14-20, the Applicant respectfully submits that Claim 14 has been amended and Claims 17-19 have been canceled. As amended, Claims 14-16 and 20, satisfy the definiteness requirement of 35 U.S.C. § 112, second paragraph. The standard for definiteness is whether the claims, “read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention.” *Hybritech Inc. v. Monoclonal Antibodies*, 231 U.S.P.Q. 81 (Fed. Cir. 1986). Claims 14-16 and 20 have been amended to include a component and exclude the limitation of providing a person. In light of the amendments, one skilled in the art would have no difficulty interpreting the scope of the claims and avoiding infringement, the very purpose of the second paragraph of § 112. See e.g., *United Carbide Co. v. Binney*

Co., 317 U.S. 228 (1942). Therefore, it is believed that the definiteness requirement of 35 U.S.C. § 112, second paragraph, is met by Claims 14-16 and 20. Accordingly, the Applicant respectfully requests that the rejections be withdrawn.

35 U.S.C. § 101

In response to rejected Claims 1-20, the Applicant respectfully submits that Claims 1 and 14 have been amended and Claims 17-19. As amended, Claims 1 and 14 are patentable under 35 U.S.C. 101. The Applicant respectfully submits that as amended independent Claims 1 and 14 each include statutory subject matter and exclude the limitation of providing a person. Therefore, Claims 1-16 and 20 are patentable under 35 U.S.C. 101 and are directed towards statutory subject matter. Accordingly, the Applicant respectfully requests that the rejections be withdrawn.

35 U.S.C. § 103(a)

In response to rejected Claims 1-20, the Applicant respectfully submits that Claims 1-20, as previously presented, are patentable under 35 U.S.C. § 103(a) over Cooperstone in view of Chao. In particular, the Applicant believes that the Examiner has not explicitly provided an apparent reason to combine the elements of Cooperstone and Chao to make the invention as claimed. According to the Court's recent decision in *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, 14 (U.S. Apr. 30, 2007), in formulating a rejection under 35 U.S.C. § 103(a) there must be "an apparent reason to combine the know elements in the fashion claimed by the patent at issue." (*Id.*) In addition, "the Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "[R]ejections on obviousness cannot be sustained by

mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at, 82 USPQ2d at 1396. Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, a reason must be identified as to why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.

The Written Office Action does not disclose an explicit reasoning to combine a wellness component and a risk management component to an association health component under the direction of the parent management company to provide additional service and programs to the members, as instructed by the Applicant. The Written Office Action argues that the motivation is “providing affordable health care plan to participants, who are members of an organization such as a business.” There is no indication in the art that the cited references do not already do so, that there is any need to combine the teachings of the references, that any such combination is likely to be successful, and how such should be combined. Accordingly, the threshold for establishing a reasoning as required under *KSR* has not been met and the Applicant respectfully requests that the rejection be withdrawn.

More, Applicant asserts that it would not have been obvious to one with ordinary skill in the art at the time the invention was made to include a system comprising a wellness component under the direction of the parent management company to provide a preventative care and wellness education service to the association health component and a risk management component providing a risk management service to the association health component under the direction of the parent company as taught by Chao, within

the system of Cooperstone et al., with the motivation of providing an affordable health care plan to participants, who are members of an organization, such as a business; because the wellness component and the risk management component described in Chao do not provide the same benefits as described by the Applicant. Therefore, the Applicant respectfully submits that the Written Office Action fails to provide some rational underpinning to combine the elements of Chao with the system of Cooperstone, when the elements of Chao do not provide the same benefits as the Applicant's disclosure. Accordingly, the Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness. In addition, the Written Office Action did not explicitly identify a reason as to why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. As a result, the Applicant respectfully submits that Claims 1-16 and 20, as previously presented, are patentable under 35 U.S.C. § 103(a). The Applicant respectfully request that the rejections be withdrawn.

Furthermore, the Applicant respectfully submits that Claims 1-16 and 20, as previously presented, are patentable under 35 U.S.C. § 103(a) over Cooperstone in view of Chao. In particular, the Applicant believes that the reason given by the Examiner in the Written Office Action to combine the elements of Cooperstone and Chao to make the claimed invention constitute impermissible hindsight; because the motivation to combine the references is taken only from the Applicants disclosure. There is no evidence at all that one skilled in the art at the time of the invention had any reasoning to combine the references. The arguments of the Written Office Action consist of bare allegations without any evidentiary support. Wherein such amounts to "taking official notice" the Applicant hereby officially requests that the official notice be supported by supporting

documentation obtained from publications available to the public before the filing date of the present application. The MPEP clearly establishes that an application may not be rejected by mere fiat, and must be supported by logical reasoning and evidence.

It is well settled that hindsight is not a proper basis for rejecting the claims. *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.* 30 U.S.P.Q.2d 1377 (Fed. Cir. 1993). In addition, “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). Furthermore, Applicants may argue that the examiner's conclusion of obviousness is based on improper hindsight reasoning; “[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account **only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure**” *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971) (emphasis added). There is no connection between the arguments of the Written Office Action and “knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made.” Therefore, the reasoning to combine elements of prior art to make the claimed invention can only have come from the applicant's disclosure and is therefore impermissible hindsight.

Therefore, the Applicant believes that the reason to combine the references is impermissible hindsight, as the advantages and benefits of the combination is disclosed by the Applicant. Accordingly, the reason given by the Examiner for the combination is impermissible hindsight. As a result, the Examiner did not explicitly identify a reason as

to why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. Therefore, Applicant respectfully submits that claims 1-20, as previously presented, are patentable under 35 U.S.C. § 103(a). The Applicant respectfully requests that the rejections be withdrawn.

Conclusion

For these reasons, it is believed that none of the prior art teaches the claimed invention. Furthermore, it is believed that the foregoing amendment has adequate support in the specification, in particular in Figure 4 and the description thereof, and accordingly there should be no new matter. Applicant believes the pending claims have addressed each of the issues pointed out by the Examiner in the Office Action. In light of the foregoing amendment, the claims should be in a condition for allowance. Should the Examiner wish to discuss any of the proposed changes, Applicant again invites the Examiner to do so by telephone conference.

Respectfully Submitted,

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Date: May 8, 2009

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